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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,067	07/16/2000	Daniel T. Papalia	EN11111	7220

7590 09/21/2004

Motorola Energy Systems Group
Intellectual Property Department
1700 Belle Meade Court
Lawrenceville, GA 30043

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,067

Applicant(s)

PAPALIA ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-19,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-19,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 3, 9 and 20 have been canceled. Claims 21 and 22 have been amended. Claims 1-2, 4-8, 10-19 and 21-22 are currently pending in the application.

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek (US 5,237,507) in view of Edelman et al. (US 6,281,601).

Chasek teaches a system for developing real-time economic incentives to encourage efficient use of the resources of a regulated electric utility, comprising:

Independent Claims.

Claims 1 and 10. A system comprising: a plurality of power machines (column 2, lines 3-9); a means for monitoring a market price of electricity (column 4, lines 14-17); a means for monitoring a market price of hydrocarbon fuels (column 5, lines 40-49).

Chasek does not specifically teach a means for actuating a power machine.

Edelman et al. (hereinafter Edelman) teaches a system and method for a distributed generation power networking system, comprising a turbo-generator,

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which is controlled (turned on and off) by a controller (column 1, line 56 - column 2, line 5), wherein said controller evaluates local data (column 6, lines 30-40).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chasek to include a means for actuating a power machine including a controller for evaluating local data, as disclosed in Edelman, because evaluation of local conditions would enhance accuracy of the system, thereby make it more attractive to the customers. Information as to *wherein after the remote means for actuating the power machines transmits an actuation signal to the power machines, the control circuitry evaluates local data stored therein prior to actuating the power machines*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1, are described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Furthermore, as per **claim 10**, information as to *wherein ... control circuitry omits evaluation of the local data upon receipt of the override signal* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

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Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 10, are described herein. Also as described the limitations of the claim 10 do not distinguish the claimed apparatus from the prior art.

Dependent Claims.

Claim 2. Edelman teaches said system, comprising a means for transmitting an actuation signal (column 1, line 56 - column 2, line 5). The motivation to combine Chasek and Edelman would be to enhance accuracy of the system by evaluating local conditions.

Claim 4. Edelman teaches said system wherein a signal causes the power machine to turn on or turn off (column 4, line 13 - column 5, line 58). The motivation to combine Chasek and Edelman would be to enhance accuracy of the system by evaluating local conditions. Information as to *override signal* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 5. Chasek teaches said system, comprising a means for reading data from a meter (column 3, lines 51-57).

Claim 6. Edelman teaches said system, further comprising a means for reading data related to the operational performance of the power machine (column 1, line 56 - column 7, line 64). The motivation to combine Chasek and

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Edelman would be to enhance accuracy of the system by evaluating local conditions.

Claim 7. Chasek teaches said system, further comprising a means for reading the local energy rate structure (column 3, line 42 - column 4, line 36).

Claim 8. Chasek teaches said system, further comprising a means for calculating the load demand and printing and preparing a billing statement (column 3, line 58 through column 5, line 23).

Claim 11. Chasek teaches said system, further comprising a means for aggregating power to sell on a power market (column 4, line 13-22).

Claim 12. Chasek teaches said system, further comprising a means for generating a billing statement (column 4, line 13-22).

Claim 13. Chasek teaches said system, wherein the electricity generation factor is selected from the group consisting of market rate structure, peak shaving information, load shedding information and information relating to the ability to sell power to the grid (column 4, line 13-22).

Claim 14. Chasek teaches said system, which operates in an environment selected from the group consisting of a traditional environment, a transitional environment, and a competitive environment (column 3, line 58 - column 5, line 57).

Claim 15. Chasek teaches said system, further comprising a means for calculating the load demand and to print and prepare a billing statement (column 3, line 58 - column 5, line 23).

Claim 16. Chasek teaches said system, further comprising a means for selling power to the grid (column 4, line 13 - column 5, line 57).

Claims 17 and 18. Edelman teaches said system, which participates in load shedding and peak shaving (column 1, line 56 - column 7, line 64). The motivation to combine Chasek and Edelman would be to enhance accuracy of the system by evaluating local conditions.

Claim 19. Chasek teaches said system, wherein the data is selected from the group consisting of electricity prices, hydrocarbon prices, resource rate structure, power machine efficiency, power machine operating characteristics, futures prices, environmental data, regulatory rules, load demand, and weather (column 3, line 29 - column 5, line 58).

Claim 22. Said system as in claim 1. Information as to *wherein the distributor monitors the operational condition of the power machines* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 22, are described herein. Also as described the limitations of the claim 22 do not distinguish the claimed apparatus from the prior art.

Dependent claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chasek in view of Edelman and further in view of Norris et al. (US 5,510,780).

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Claim 21. Chasek in view of Edelman teach all the limitations of **claim 21**, except specifically teaching a distributor capable of licensing the power machines.

Norris et al. teach a system for controlling a power-generation equipment wherein said equipment is leased (column 1, lines 6-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Chasek and Edelman to include licensing of power machines, as disclosed in Norris, because it would advantageously increase revenue thereby make it more attractive to the customers.

Response to Arguments

Applicant's arguments filed 6/23/04 have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art does not teach *evaluating local data after the receipt of a control signal and before actuation of the power machines*, it is noted that Chasek in view of Edelman disclose a system comprising: a plurality of power machines a means for monitoring a market price of electricity a means for monitoring a market price of hydrocarbon fuels; and a controller which evaluates local data (See discussion above). The "wherein" clause including: *after the remote means for actuating the power machines transmits an actuation signal to the power machines, the control circuitry evaluates local data stored therein prior to actuating the power machines*, is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

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apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

In response to applicant's argument that the prior art does not teach *wherein ...control circuitry omits evaluation of the local data upon receipt of the override signal*, the examiner maintains that the "wherein" clause is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

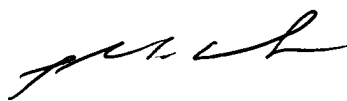
or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451
Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

9/13/2004


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